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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,622	01/28/2002	Charles Achim Bernard Boucher	DVME-1014USCON1	4855

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EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

3M.

Advisory Action

Application No.

10/058,622

Applicant(s)

BOUCHER, CHARLES ACHIM
BERNARD

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 21-63.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 28 January 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

C. Mu 1 f
May 10, 2004

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER
AU1631

5/11/04

Continuation of 5. does NOT place the application in condition for allowance because:

Applicants' state that a method to derive "rules" from publications is not being claimed. Applicants' argue a person of ordinary skill in the art is already capable of deriving the "rules" to be used for the "rules database" and thus does not need to be taught how to do this by the present specification. Applicants further state the "rules" are derived by members of a core-committee (via an "actual rules derivation process") and that the claims cover any method for assigning these values that involves use of the information specified in the claims, an a skilled person, exercising common general knowledge, is capable of assigning these values without requiring further guidance from the present application.

Applicants' arguments are found unpersuasive. The claimed invention contains subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The "rules" for the "rules database" and/or derivation of said "rules" are absent from the specification. In such absence one of skill in the art would be unable to derive said "rules" thereby making and using the "rules database" for the instantly claimed invention. The specification fails to provide the "actual rules derivation process" (Applicants response) as to the manner in which the core-committee derives said rules. Again, the derivation of said rules is considered undue because it is unclear what the core-committee is performing with respect to the scientific literature to make said rules. Applicants are directed to Fields, Wilkinson, and Kende v. Conover and Woodward [170 USPQ 276; How-to-Make Requirement section] which states: "the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this, it must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it.". Thus, the specification fails to provide one of skill in the art proper guidance to make and/or use the claimed method, computer program device, and computer program carrier. It should be noted Applicants' amendment to claim 21 replacing "providing" with "using" does not further clarify the instant claim, wherein the language is viewed as equivalent and does not enable the instantly claimed invention for the derivation of said "rules".